

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/671,924
Applicant : Andrew S. Poulsen
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TC/A.U. : 2619
Examiner : Moutaouakil, Mounir

Docket No. : 10021064-01

Confirmation No. 8482

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

Sir:

This Pre-Appeal Brief is filed in response to the Final Office Action mailed Oct. 8, 2008. Claims 1-12 and 14-25 remain in the application, all of which stand rejected. Claim 13 was previously canceled.

Claims 1-4, 6-9, 14-16 and 18-23 stand rejected under 35 USC 102(e) as being anticipated by Loveland (US Patent No. 6,782,413).

Applicant's claim 1 recites:

1. An instrument system, comprising:
an electronic test instrument; and
a network interface module having a first connector for connecting with the electronic test instrument, a second connector for connecting with a voice module, and a third connector for connecting with a network, wherein the network interface module and the electronic test instrument are configured to interchange instrument data via the first connector, wherein the network interface module and the voice module are configured to interchange voice data via the second connector, wherein the voice data is in the form of an electronic signal, wherein the network interface module and the network are configured to interchange combined voice and instrument data via the third connector, and wherein the network interface module is configured to effect transposition between combined voice and instrument data and separated instrument data and voice data.

With respect to claim 1, the Examiner asserts that Loveland teaches an "electronic "electronic test instrument (130, 134, or 132)" in FIG. 2. Applicant disagrees and believes the Examiner is reading the limitation of a "test instrument" so broadly that the limitation is being read out of the claim. That is, applicant does not believe one of ordinary skill in the art would consider any of the generic computing devices 130, email server 132 or database server 134 to be an "electronic test instrument". Claim 1 is believed to be allowable for at least this reason.

In responding to applicant's amendment of claim 1 to recite an "electronic test instrument", the Examiner noted that claims are to be given their broadest reasonable interpretation. The Examiner further noted that:

...the claims do not limit the recitation of "electronic test instrument" and do not state its specific functionalities to further distinguish it from any available/known instrument or device in the same field of endeavor.

10/8/2008 Final Office Action, p. 9.

However, applicant notes that claims are only to be given their broadest "reasonable" interpretation. Here, the Examiner has asserted that Loveland discloses an "electronic test instrument", without providing any explanation regarding how or why one of ordinary skill in the art would consider a generic computing device, email server or database server to be a "test instrument" (or otherwise have anything to do with "test"). It is applicant's position that Loveland neither teaches nor suggests an "electronic test instrument". Claim 1 is believed to be allowable for at least this reason.

In the Final Office Action mailed October 8, 2008, the Examiner also noted that "it is generally considered improper to read limitations contained in the specification into the claims." See, 10/8/2008 Final Office Action, p. 8. However, applicant is not trying to read an "electronic test instrument" into claim 1. Rather, an "electronic test instrument" is clearly recited as an element of claim 1. The Examiner's cautionary language therefore seems misplaced.

Applicant asserts that the Examiner has not made a prima facie for rejecting claim 1. Specifically, the examiner has committed clear error in rejecting claim 1, because the Examiner has not shown where the art of record discloses "An instrument system, comprising: ***an electronic test instrument***, and a network interface module", as fully described in claim 1.

As an aside, applicant notes that an RCE was filed on February 19, 2008, because the Examiner's Advisory Action mailed January 18, 2008 indicated that applicant's introduction of the phrase "electronic test instrument" raised new issues. Yet, the Examiner continues to reject claim 1 over the same art, and on the same basis (pre- and post-RCE). Once again, applicant asserts that the Examiner is improperly reading an "electronic test instrument" out of the claim, and the Examiner has not shown where Loveland discloses any sort of test instrument.

Claims 2-4, 6-9, 14-16 and 18-23 are believed to be allowable, at least, because each of these claims ultimately depends from claim 1.

Claims 5, 10, 11, 12, 17 and 24 stand rejected under 35 USC 103(a) as being unpatentable over Loveland (US Patent No. 6,782,413). However, applicant asserts that claims 5, 10, 11, 12, 17 and 24 are allowable, at least, because each of these claims ultimately depends from claim 1, which is believed to be allowable for the reasons already set forth.

Claim 25 stands rejected under 35 USC 103(a) as being unpatentable over Loveland (US Patent No. 6,782,413) in view of Lashley et al. (US Patent No. 7,003,085; hereinafter "Lashley"). However, applicant asserts that claim 25 is allowable, at least, for reasons similar to why claim 1 is believed to be allowable, and because Lashley fails to disclose that which is missing from Loveland.

In light of the arguments provided herein, applicant respectfully requests the issuance of a Notice of Allowance.

Respectfully submitted,
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